

Application No. 10/328,895
Amendment Dated 12/27/2005
Reply to Office Action of September 29, 2005

REMARKS/ARGUMENTS

By this Amendment, the specification is amended. Claims 1-30 are pending.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

OBJECTIONS TO THE DRAWINGS:

The Examiner first objected to the drawings for including reference characters not mentioned in the description. The Examiner stated that features 56a and 34 are not disclosed in the specification.

With respect to feature 56a, it was originally disclosed in the specification at page 11, line 21 (as weld).

With respect to feature 34, this feature is epoxy. The specification is amended to include character number 34 for epoxy at page 11, lines 15, 16 and 17.

No new matter has been added.

It is respectfully requested that that the Examiner withdraw the objection to the drawings.

OBJECTIONS TO THE SPECIFICATION:

Next, the Examiner objected to the specification. First, the Examiner stated that on page 11, line 5, "cable 22" should be "cable 44." Next, on page 11, line 24, the Examiner stated that "upper flange 64a" should be "upper flange 62a." The specification is amended accordingly. It is respectfully requested that the Examiner withdraw the objections to the specification.

REJECTIONS UNDER 35 U.S.C. § 103(a):

The Examiner rejected claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,442,903 (Schutt et al.) in combination with U.S. Patent No. 4,871,328 (Wright et al.). The Examiner states that Schutt et al. disclose the invention except for the first and second removable pressure seal fittings. The Examiner states that Wright et al. disclose a seal housing that hermetically seals the electrical connections. The Examiner goes on to state that the subject matter as a whole would have been obvious to one having ordinary skill in the art because even though Schutt et al. do not teach the first and second removable pressure seal fittings, it would have been within the ability of the person having ordinary skill to use such a seal in pipelines to seal water or other constituents from getting to the electrical connections. The Examiner states that even though Schutt et al. is primarily directed to a bore hole in the ground, Schutt et al. does disclose that this system could be used in pipelines to protect pipes.

The first and second removable pressure seal fittings of the present invention, as claimed in claim 1, are a critical element to one embodiment of the present invention. The flexible anode assembly must have a first and a second end where the first removable pressure seal fitting is for the first end and the second removable pressure seal fitting is for the second end of the anode assembly. The pressure seal fittings provide for electrical contact between the two ends of the anode assembly and contacts outside of the internal volume of the pipeline. The Schutt et al. patent shows the conductors 47, 54 that are attached to the two ends of the anode extending out of a single bore hole with no pressure seal fittings. See FIGS. 3 and 7. There is no teaching of even one pressure seal fitting, let alone two pressure seal fittings (one at each end of the anode).

Even if one skilled in the art were to attempt to combine the teachings of Schutt et al. and Wright et al., the present invention would not be found. As stated, Schutt et al. is directed to a single hole location where the an anode is placed into a bore hole and connections made. The Examiner states that it would have been obvious to use a seal in pipelines to seal water. However, it would not have been obvious based on the cited prior art to have two hole locations where each end of the anode is associated with a single hole. Taking the Examiner combination, the invention of Schutt et al. would essentially be turned sideways, but access to the anode in the pipeline would only be at a single pressure seal fitting, not two as in the present invention.

It is respectfully requested that the Examiner withdraw the rejection to claims 1-15 and pass these claims to allowance and issuance.

The Examiner next rejected claims 16-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,176,807 (Kumar) in combination with the Schutt et al. patent and the Wright et al. patent. The Examiner states that Kumar discloses the invention except for the pressure seal fitting or a pipeline. The Examiner cites Schutt et al. and Wright et al. for essentially the same reasons as that stated above. The Examiner states that the subject matter as a whole would have been obvious at the time the instant invention was made because even though Kumar does not disclose the cathodic protection system used in a pipeline, one having ordinary skill in the art would recognize that such a system is capable of being used in another application where water is contained so as to protect the internal volume of the container. The Examiner states that Kumar shows that the anode assembly is sealed at the top of the water tank, but does not disclose the pressure seal as set forth in the present application, as claimed. The

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Examiner states that Wright et al. show such a seal for the purpose of sealing the electrical connections through the use of a hermetic seal formed by a housing having a flange that seals between the two housings. The Examiner states that the prior art of Kumar in combination with Schutt et al. and Wright render the present invention obvious.

Kumar, alone or in combination with the prior art of record does not teach or suggest the present invention. Kumar is for a tank, not a pipeline; therefore, an entirely different set of features is required. Similar to claim 1 above, claim 16 is directed to a pipeline and requires, among other things, a first removable pressure seal fitting for the first end of the anode assembly, providing for electrical contact between the first end of the anode assembly of the pipeline and a first contact outside of the internal volume of the pipeline. Additionally, the length of the anode assembly must be of a greater dimension than that of a diameter of the pipeline and free to move within the pipeline due to the flexibility of the anode assembly. None of this is relevant to Kumar since it is directed to a tank. Schutt et al. merely mentions use of a pipeline. No reference is made to how one would implement its use in a pipeline. Furthermore, nothing in any of the prior art of record would suggest to one skilled in the art to combine these references.

It is respectfully requested that the Examiner withdraw the rejection to claims 16-30 and pass these claims to allowance and issuance.

As stated by the Federal Circuit,

[i]n proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

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In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The Federal Circuit went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, the Examiner clearly used impermissible hindsight to piece together the teachings of Schutt et al. and Wright et al. or Kumar, Schutt et al. and Wright et al. With respect to the rejection of claims 1-15, nothing in any of these patents suggests using two pressure seal fittings at the two ends of an anode. With respect to the rejection of claims 1-16, nothing in any of these patents suggests making use of Kumar in a pipeline and having a length of an anode assembly being of a greater dimension than that of a diameter of the pipeline.

It is therefore respectfully requested that the Examiner withdraw the rejections under 35 U.S.C. § 103 and pass all of claims 1-30 to allowance and issuance.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

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Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

December 27, 2005

Please charge or credit our
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